



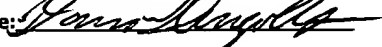
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No.: 09/458,858
Assignee: NMB, U.S.A., INC.
Title: INTEGRATED USB INPUT
DEVICE
Appellant: Jamin Pandana
Filed: December 10, 1999
Examiner: X. Wu
Group Art Unit: 2674
Docket No.: 861975/0089

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APPEAL BRIEF (UNDER 37 C.F.R. 1.192)

Appellant appeals the Examiner's final rejection dated January 28, 2002.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee NMB, U.S.A. Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-13 are under consideration. Claims 1, 2 and 6-11 stand rejected under 102(e) as being anticipated by U.S. Patent No. 5,943,506 to Poisner. Claims 3-5 are rejected under 103(a) as being unpatentable over Poisner in view of U.S. Patent No. 5,706,031 to Brendzel. Claims 12

and 13 are rejected under 103(a) as being unpatentable over Poisner. The rejections of Claims 1-13 are being appealed. The Claims on Appeal appear in Exhibit A attached hereto. A copy of the Final Office Action of January 28, 2002 appears as Exhibit B attached hereto.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been proposed since the Final Office Action of January 28, 2002.

V. SUMMARY OF INVENTION

The present invention provides an input device for a computer system that has a keyboard having a function controller therein. Further, a pointing device shares the function controller. In the present invention, the Universal Serial Bus (USB) function controller is located inside the keyboard. The pointing device is thus, connected via the keyboard.

More particularly, the present invention is directed to an apparatus that satisfies the need for a cost-effective input device for use in computer systems that are designed to operate in a high bit rated USB environment. Specification page 3, lines 26-28. The first embodiment is shown in Figs. 1 and 2, and the second embodiment is shown in Figs. 3 and 4. In both preferred embodiments, the input system 100 comprises a keyboard 200 having a function controller 270 for providing output signals in the computer system in accordance with a USB technique. See Specification page 6, line 20-page 7, line 4. A pointing device 300 is coupled to the function controller 270. The keyboard and the pointing device **share the same** function controller. Specification page 4, lines 3-4. The function controller is part of and **located within** the keyboard as shown in the drawings. The pointing device is connected via the keyboard. The pointing device such as a mouse can be dumb. Specification page 6, lines 2-9.

The pointing device may be hard-wired to the function controller as shown in Figs. 1 and 2, or the pointing device may be coupled to the function controller using a wireless technique as shown in Figs. 3 and 4.

VI. ISSUES

A) Whether the Examiner met his burden of proof for proving that the claims 1, 2 and 6-11 are anticipated under 35 U.S.C. §102(e) by Poisner.

B) Whether claims 1, 2 and 6-11 are anticipated under 35 U.S.C. §102(e) by Poisner.

C) Whether claims 3-5 were properly rejected under 35 U.S.C. §103(a).

D) Whether claims 12-13 were properly rejected under 35 U.S.C. §103(a).

VII. GROUPING OF CLAIMS

Claims 1, 2, 7, 8, 9, 11 and 12 will stand or fall together. Claims 3-5 will stand or fall together. Claims 6, 10 and 13 will stand or fall together.

VIII. ARGUMENT

A. THE BURDEN IS ON THE PATENT OFFICE TO SHOW THAT APPELLANT IS NOT ENTITLED TO A PATENT

The Patent Statute 35 U.S.C. §102 states: "A person shall be entitled to a patent unless . . ." Thus, the burden is on the Patent Office to prove that an Appellant is not entitled to a patent. According to the MPEP, the Patent Office bears the initial burden of factually supporting any conclusion of anticipation or prima facie case of obviousness.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must

be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipissimis verbis* test, i.e. identity of terminology is not required. *In re Bond*, 970 F.2d 831 (Fed. Cir. 1990).

**B. CLAIMS 1, 7 AND 12 REQUIRE THE FUNCTION CONTROLLER
LOCATED WITHIN THE KEYBOARD**

The Final Office Action at page 4 states: "With respect to claims 1-11, Applicant argues that the USB controller 32 of Poisner is not located within the keyboard. This argument is not persuasive because this limitation is not found in the claims." Exhibit B, paragraph 6.

Contrary to the comments in the Final Office Action, Claim 1 recites that the controller is within the keyboard by the language "a keyboard having a function controller." Further, Claim 7 recites "a first peripheral device having . . . a function controller." Additionally, Claim 12 recites "a keyboard having a function controller therein." Poisner does not disclose this feature.

**C. THE PATENT OFFICE ACKNOWLEDGED POISNER DOES NOT
DISCLOSE THE USB CONTROLLER LOCATED WITHIN THE KEYBOARD**

In the Office Action, it was acknowledged by the Examiner that Poisner does not specifically disclose that the USB controller is located within the keyboard. At paragraph 5, page 3 of the Final Office Action (Exhibit B), it is stated: "Poisner does not specifically discloses [sic] that the USB controller is located within the USB keyboard."

Thus, the rejections of Claims 1 and 7 for anticipation should be reversed.

D. THE FINAL REJECTION OF CLAIM 12 FOR OBVIOUSNESS FAILS TO CITE A REFERENCE FOR THE MISSING FEATURES

With respect to Claim 12, the Final Office Action states: "it would have been obvious to have integrated the USB controller into the USB keyboard because it is [sic] alternative way to integrate the USB control either into the computer or into the keyboard."

No evidence was set forth that the USB controller of Poisner was located anywhere but in the PC. The Examiner did not provide support for a teaching that integrating the USB control in the keyboard was a known alternate. On the contrary, it was common practice to place the controller inside the PC portion of the computer. Therefore, if not specifically indicated otherwise, it was known to persons having ordinary skill in the art to place the controller inside the PC, not the keyboard.

E. THE REJECTIONS OF CLAIMS 1 AND 7 FOR ANTICIPATION AND CLAIM 12 FOR OBVIOUSNESS LACK SUBSTANTIAL EVIDENCE SUPPORT

The Final Office Action cites no reference for the claimed limitation missing from Poisner (i.e. the controller located within the keyboard), but rather asserts it is obvious "because it is [sic] alternative way to integrate the USB control into the computer on into the keyboard." Exhibit B at page 3, paragraph 5.

In a Notice of February 21, 2002 (copy attached as Exhibit C) regarding PTO procedures for relying on facts which are not of record as common knowledge, it is stated that "in *Zurko* [258 F.3d 1379 (Fed. Cir. 2001)] and after recent claims, the court criticized the USPTO's reliance on "basic knowledge" or "common sense" to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." The Notice further states:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted

to be well known are not capable of instant and unquestionable demonstration as being well-known.

* * *

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.

Exhibit C, page 2.

Additionally, the Notice states:

If Appellant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.

If Appellant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.

In this case it is acknowledged that Poisner does not disclose a USB function controller within a keyboard. No further reference is cited. The rejections lack substantial evidence support. Appellant respectfully submits that the independent claims are allowable and the Final rejection should be reversed. Appellant further maintains that documentary evidence must be provided if the rejection is maintained. Further, if the Patent Office maintains that anticipation or obviousness can be established without a teaching of locating the controller in the keyboard, it is respectfully submitted that the Patent Office is propounding a new interpretation of the law of anticipation and obviousness. Further, Appellant requests that a motivation to combine any newly asserted reference with Poisner be identified and that such motivation to combine be found within the prior art.

F. THE PURPORTED OBVIOUSNESS REJECTIONS FAIL TO MEET
MINIMUM MPEP REQUIREMENTS FOR A PROPER STATEMENT OF
REJECTION

Claims 3-5 and 12-13 are rejected for obviousness.

The MPEP sets out a form for the reasoning under which claims are to be examined for obviousness. After the difference between the claim and the prior art has been determined under the first steps of the *John Deere* analysis, the MPEP instructs how to analyze the “obviousness of the difference” between a claim and the prior art. An overview of this analysis is stated at § 2143 (and, is repeated twice more in §§ 706.02(j) and 2142). Note that, in two short paragraphs, the MPEP reiterates five times that this form of reasoning is mandatory. This, and no other, is the form of reasoning that must be used (emphasis added):

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further requirements of these three reasoning steps are elaborated in §§2143.01-2143.03, and the permissible “Sources of Rationale” that must underlie each of the steps are set out in §§ 2144-2144.09.

The written rejection does no more than compare the elements of the claim to the prior art. That is, the written rejection makes a facial attempt only to comply with the third of the three elements of *prima facie* obviousness.

The purported rejection states that it would have been “obvious,” but makes no attempt to make the three underlying showings required to support either assertion. Significantly, there is no suggestion or motivation to modify Poisner.

Because the written rejection fails to even make a facial attempt to be complete, the § 103(a) rejection are improper.

Chapter 2100 is binding on examiners and has created settled expectations for Appellants to have applications examined in accordance with predictable legal standards.

The Board is petitioned to provide “management and direction” to an examiner who has demonstrated either an inability or a willful refusal to carry out the minimum duties imposed by the MPEP. The Board is requested to supervise the Examiner to ensure that any future obviousness rejection follows the form of reasoning set out at MPEP §§ 2143-2143.03. The Examiner must make the showings set out in MPEP §§ 2143-2143.03, and must support each with evidence drawn from the “Sources of Rationale” set out in MPEP § 2144-2144.09. If the claims remain rejected, the Examiner should be instructed that his written rejection must state specific findings on each of the required elements of a *prima facie* case, at least to the degree that issues have been traversed in any of Appellant’s previous papers. Any further rejection should set out this analysis in writing so that Appellant can respond with appropriate claim amendments or arguments. The Board should instruct the Examiner that it is beyond his discretion to create his own reasoning for obviousness. The Examiner should be instructed that he must use the MPEP reasoning and *no other*.

G. THERE IS NO MOTIVATION TO COMBINE THE ELEMENTS OF POISNER WITH BRENDZEL

Claims 3-5 are rejected based upon a combination of Poisner and Brendzel. It would not have been obvious to combine the elements of Poisner with Brendzel to achieve the present invention. In fact, Brendzel is only cited for a wireless pointing device and Brendzel does not eliminate the deficiencies noted in Poisner.

H. THE DEFENDANT CLAIMS ARE ALSO PATENTABLE

Since Claims 2-6, 8-11 and 13, depend from Claims 1, 7 and 12, they are not anticipated nor obvious for at least the same reasons as set forth with respect to Claims 1, 7 and 12.

I. POISNER FAILS TO DISCLOSE A "DUMB" POINTING DEVICE

The Examiner made the statement that the pointing device of Poisner is "dumb" because it is controlled by the USB controller. However, the Appellant does not find support for this statement in the Poisner reference. Without an explicit statement that the Poisner controller is located within the keyboard or other teaching to located the controller in the keyboard, rather than inside the PC as was conventional, the Patent Office has failed to meet its burden. The rejection of Claims 6, 10 and 13 lacks substantial evidence support and fails to comply with § 2143 of the MPEP as argued above. Thus, the rejections of Claims 6, 10 and 13 related to a "dumb" pointing device, should be reversed.

J. THERE IS NO PROOF THAT LOCATING THE CONTROLLER WITHIN THE
KEYBOARD IS INHERENT IN POISNER

In the event that the Final Office Action bases the assumption that Poisner has a USB controller within the keyboard upon the theory of inherency, the proof of inherency is not met by the Final Office Action. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Here, it does not necessarily flow that the controller of Poisner is located in the keyboard. In fact, typically the controllers of prior art systems are located in the PC. The test for inherency cannot be met.


IX. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the Final Rejection of Claims 1-13 should be reversed.

Serial No.: 09/458,858
Atty Dkt. No. 861975/0089

Respectfully submitted,

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Dated: December 19, 2002
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